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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,260	06/24/2003	Ghee Hong Jin	YPL-0058	6327
7590	05/14/2004		EXAMINER	
Cantor Colburn LLP 55 Griffin South Road Bloomfield, CT 06002			SAIDHA, TEKCHAND	
			ART UNIT	PAPER NUMBER
			1652	
DATE MAILED: 05/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/603,260	JIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tekchand Saidha	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1652

### **DETAILED ACTION**

1. The Preliminary Amendment filed June 24, 2003 is acknowledged. Claims 1-13 are pending and under consideration in this examination.

2. ***Priority***

Acknowledgment is made of applicants' claim for priority based on an application filed in Korea on June 24, 2002.

3. ***Sequence Rules***

The instant specification [see drawings Figures 4A, 4B and 6], present nucleotide and/or amino acid sequences that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2), but fails to comply with the requirements. According to 37 CFR 1.821-825, every disclosed amino acid sequence of four or more residues or 10 or more nucleotides must be identified by a SEQ ID NO. The amino acid sequences presented do not have SEQ ID Nos. In order to comply with the sequence rules Applicants must identify these sequences by providing SEQ ID NO :, and where required provide a new version of the sequence listing and disk.

It appears that the sequences depicted in Figures 4A and 4B are already included in the sequence listing. If so, the SEQ ID No(s). may be included in the Figure legend to the figure on page 3 of the instant specification. However, the comparison amino acid sequences shown in Figure 6, have neither been identified by SEQ ID Nos., nor the short sequences included in the sequence listing.

Appropriate corrections and inclusion of sequences for compliance are required.

### ***New Sequence Rules***

Since the effective filing date after July 1, 1998, Applicants should follow the New Rule Format and submit a new Sequence Listing (both in electronic and paper format). Compliance according to the requirements of 37 CFR 1.821 through 1.825 is required.

#### **4. *Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### **5. *Deposit Requirement***

Claims 7-13 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that the [plasmid/microorganism/vector] is required to practice the claimed invention. As such the [plasmid/microorganism/vector] must be readily available or obtainable by a repeatable method set forth in the specification, or otherwise readily available to the public. If it is not so obtainable or available, the requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit of the [plasmid/microorganism/vector]. The specification lacks complete deposit information for the deposit of [plasmid/microorganism/vector]. If a deposit was made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the

Art Unit: 1652

instant invention will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein. If a deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809 and MPEP 2402-2411.05, Applicant may provide assurance of compliance by affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that (a) during pendency of the application, access to the invention will be afforded to the Commissioner upon request, (b) all restrictions upon availability to the public will be irrevocable removed upon granting of the patent, (c) the deposit will be maintained in a public depository for a period of 30 years, or 5 years after the last request or for the enforceable life of the patent, whichever is longer, (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807) and (e) the deposit will be replaced if it should ever become inviable.

Claims 7, 10 & 13 are drawn to recombinant vectors pHL1, pHLB29, or pHAAH38. Applicants have not provided statement or affidavit under 37 C.F.R. 1.808 that all restrictions on the availability to the public will be irrevocable removed upon granting of the patent. The deposit will be maintained in a public depository for a period of 30 years, or 5 years after the last request or for the enforceable life of the patent, whichever is longer, (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807) and (e) the deposit will be replaced if it should ever become inviable. Further, proof of biological deposit under the Budapest treaty for pHAAH38 is not received at the PTO.

Claims 7-13 rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. Claims 8-9 & 11-12 are included in the rejection for failing to correct the defect present in the base claim(s).

**EFFECTIVE MARCH 23, 1998 : New address for ATCC deposits.**

**AMERICAN TYPE CULTURE COLLECTION**

10801 University Boulevard, Manassas, VA 20110-2209

**6. Claim Rejections - 35 USC . § 112 (second paragraph)**

Claims 8-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, line 1, recites 'The transformed host cell transformed by', which is confusing because of the use of the word 'transformed' twice in an inappropriate manner. Amending the claim to recite 'The transformed host cell comprising the recombinant vector of claim 6', instead, will overcome this rejection.

Claim 13, recites 'A detergent comprising ', which is confusing as inadequately supported by its meaning. Amending the claim to recite 'A detergent composition comprising', will overcome this rejection.

Claims 9-12 are included in the rejection for failing to correct the defect present in the base claim(s).

**7. 35 U.S.C. § 101**

35 U.S.C. . § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement

Art Unit: 1652

thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1-13 are rejected under 35 U.S.C. § 101 because the claimed invention is directed toward non-statutory subject matter.

In the absence of the hand of man, naturally occurring proteins and/or nucleic acids are considered non-statutory subject matter. *Diamond v. Chakrabarty*, 206 USPQ 193 (1980). This rejection may be overcome by amending the claims 1 and 2 to recite wording such as "An isolated alkaline lipase" [claim 1] or "An isolated polynucleotide".

Claims 3-13 are included in the rejection for failing to correct the defect present in the base claim(s).

8. No claim is allowed.

9.. During a telephone interview with the Applicants' representative, Soonja Bae, on May 6, 2004, allowable subject matters were discussed and Applicants were invited to amend the claims or provide the 'deposit statement under 1.808' in order to place the case in condition for allowance. However, the discussion did not result in an agreement being reached hence this Office Action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha (Ph.D.) whose telephone number is (571) 272-0940. The examiner can normally be reached on Monday-Friday from 8:15 am to 4:45 pm.

Art Unit: 1652

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group in the Technology Center is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 571 272-1600.



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May 11, 2004